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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,238	07/12/2001	Shell Sterling Simpson	10008180-1	3497

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EXAMINER
SINGH, SATWANT K

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/905,238	SIMPSON ET AL.
	Examiner	Art Unit	
	Satwant K. Singh	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2005*.

2a)☐ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-30* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the amendment filed on 5 December 2005.

Response to Arguments

2.   Applicant's arguments filed 5 December 2005 regarding claims 1-9 and 11-14 have been fully considered but they are not persuasive.

3.   In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4.   In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

5.   Regarding Claims 1, 11 and 14, applicant submits that Davis et al fails to teach
where the print options are automatically identified based at least in part on the
characteristics of the request. The examiner respectfully disagrees. Print options are
sent from a client application to a remote printer via a remote computer. One of
ordinary skill in the art could certainly understand that in order for the requested job to
be printed by the remote printer on the basis of print options/instructions sent by the
user, the remote computer would have to automatically interpret/recognize the pint
options in order to successfully print the print job. The examiner has examined related
art in this field for a number of years, and is certainly "one of ordinary skill in the art".
There is no additional need for the examiner to provide a report on the levels of
"ordinary skill in the art" to show any further motivation for this 103 rejection.

6.   Regarding Claims 2 and 3, applicant submits that Davis et al fails to teach print
options being identified by user selection of a named print option configuration. The
examiner respectfully disagrees. Please refer to the applicant's arguments as
pertaining to claim 1 above.

7.   Regarding Claim 5, applicant submits that the file name as disclosed by Okigami
is not automatically identified by the print option. The examiner respectfully disagrees.
Okigami discloses in col. 9 lines 22-36, "when the user instructs the terminal device to
print contents of file data, the terminal device sends print requesting data comprising
data specifying information for specifying the contents of the pint data". The print
procedure, which reads on print options, is automatically chosen based on file name
(col. 11, lines 15-23).

8.   Regarding Claim 6, applicant submits that the file size as disclosed by Okigami is

not automatically identified by the print option. The examiner respectfully disagrees.

Okigami discloses in col. 9 lines 22-36, "when the user instructs the terminal device to

print contents of file data, the terminal device sends print requesting data comprising

data specifying information for specifying the contents of the pint data". The print

procedure, which reads on print options, is automatically chosen based on file size (col.

11, lines 15-23).

9.   Regarding Claims 7 and 8, applicant submits that Okigami fails to teach

automatic identification being carried out in connection with a set of rules that map

characteristics to print options. The examiner respectfully disagrees. Okigami

discloses changing the number of copies to be made, which reads on print options,

based on data specified information, which reads on characteristics (col. 8, lines 12-27).

This certainly reads on comparing characteristics based on rules that map

characteristics based on print options.

10.   Regarding Claim 9, applicant submits that Davis et al fails to teach print options

automatically identified by a print service associated with a remote printing device. The

examiner respectfully disagrees. Davis et al disclose teaching print options

automatically identified by a print service associated with a remote printing device which

reads on the remote computer system as stated in pages 2 and 3, paragraph [0026].

11.   Regarding Claim 13, applicant submits that Okigami fails to teach storing

indications of print options. The examiner respectfully disagrees. Okigami disclose

storing indications of print options, which reads on storing the number of copies to be printed.

12. Applicant's arguments, see amendment, filed 5 December 2005, with respect to claims 15 and 27 have been fully considered and are persuasive. The final rejection of 3 October 2005 has been withdrawn.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-3, 9, 11, 12, 14-18, and 26 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Davis et al. (US 2002/0059489).

15. Regarding Claim 1, Davis et al teach one or more computer readable media having stored thereon a plurality of instructions that, when executed by one or more processors, causes the one or more processors to perform acts including: receiving, from a client computing device (user of local computer 20 wishes to print data on remote printer) (page 2, paragraph [0025]), a request to print an image on a remote printing device (select "Print " command) (page 2, paragraph [0025]), wherein a printer driver for the printing is not installed on the client computing device (local computer can use remote printer, even if no printer driver exists for the remote printer) (page 4, paragraph [0040]); and applying one or more print options identified by the request

when printing the image (application 42 sends document to file manager 44 with specific destination printer and print option information) (page 2, paragraph [0025]).

Davis et al fail to specifically point out where the one or more print options are automatically identified based at least in part on one or more characteristics of the request.

It would have obvious to one skilled in the art at the time of the invention that the print options sent by the user via the remote computer would have to be automatically interpreted/recognized by the remote printer in order for the print job to be successfully outputted.

16.   Regarding Claim 2, Davis et al disclose one or more computer readable media, wherein the one or more print options are identified by user-selection of a named print option configuration (user of local computer wishes to print data on remote printer, selects "Print" command from the user interface of application 42) (application 42 sends document to file manager 44 with specific destination printer and print option information) (page 2, paragraph [0025]).

17.   Regarding Claim 3, Davis et al fail to specifically point out one or more computer readable, wherein the one or more print options are automatically identified by the remote printing device.

It would have obvious to one skilled in the art at the time of the invention that the print options sent by the user via the remote computer would have to be automatically interpreted/recognized by the remote printer in order for the print job to be successfully outputted.

18.   Regarding Claim 9, Davis et al teach one or more computer readable media,

wherein the one or more print options are automatically identified by a print service

associated with the remote printing device (remote computer system (pages 2 and 3,

paragraph [0026]).

19.   Regarding Claim 11, Davis et al teach a method comprising: receiving a user-

selection of print options associated with a print service accessible to a client computing

device (local computer wishes to print data on remote printer 26), wherein the print

service represents an associated printer (remote printer 26) (page 2, paragraph [0025]);

storing, remotely from the client computing device, the user-selected print options along

with a user-identified name for the print options (relay process 55 stores the data in

queue for later use) (page 2, paragraph [0025]); and subsequently using the user-

selected print options to print a document identified in a print request (application 62

automatically opens, loads the data, and prints it out on remote printer) (pages 2-3,

paragraph [0026]).

        Davis et al fail to specifically point out a method, wherein the user-selected print

option are automatically identified based at least in part on one or more characteristics.

        It would have obvious to one skilled in the art at the time of the invention that the

print options sent by the user via the remote computer would have to be automatically

interpreted/recognized by the remote printer in order for the print job to be successfully

outputted.

20.   Regarding Claim 12, Davis et al teach a method, further comprising allowing the

receiving and storing without requiring a printer driver for a printer corresponding to the

print service to be installed on the client computing device (local computer can use

remote printer, even if no printer driver exists for the remote printer) (page 4, paragraph

[0040]).

21.   Regarding Claim 14, Davis et al teach a method, comprising: receiving, from a

client computing device (user of local computer 20 wishes to print data on remote

printer) (page 2, paragraph [0025]), a request to print an image (select "Print "

command) (page 2, paragraph [0025]) and an identifier of a set of print options

(application 42 sends document to file manager 44 with specific destination printer and

print option information) (page 2, paragraph [0025]); and accessing a location other than

the client computing device to obtain the identified collection of printer configuration

options.

Davis et al fail to teach a method, wherein the print options are automatically

identified based at least in part on one or more characteristics of the request.

It would have obvious to one skilled in the art at the time of the invention that the

print options sent by the user via the remote computer would have to be automatically

interpreted/recognized by the remote printer in order for the print job to be successfully

outputted.

22.   Regarding Claim 15, Davis et al teach a method comprising: receiving a print

request identifying a document to be printed (user of local computer wishes to print data

on remote printer, selects "Print" command from the user interface of application 42)

(application 42 sends document to file manager 44 with specific destination printer and

print option information) (page 2, paragraph [0025]).

Davis et al fail to teach a method automatically identifying, based at least in part on one or more characteristics of the print request, a set of print options to be used when printing the document.

It would have obvious to one skilled in the art at the time of the invention that the print options sent by the user via the remote computer would have to be automatically interpreted/recognized by the remote printer in order for the print job to be successfully outputted.

23.   Regarding Claim 16, Davis et al teach a method, wherein the document comprises a composition document including multiple images (application collects printable data such as images) (page 2, paragraph [0025]).

24.   Regarding Claim 17, Davis et al teach a method, wherein receiving the print request comprises receiving the print request at a printer (file managers 44,64 communicate directly without the use of relay server 28) (page 3, paragraph [0029]).

25.   Regarding Claim 18, Davis et al teach a method, wherein receiving the print request comprises receiving the print request at a print service associated with a printer (relay server 28) (page 2, paragraph [0024]).

26.   Regarding Claim 26, Davis et al teach a method, further comprising allowing the user to override the automatically identified print options (user of local computer wishes to print data on remote printer, selects "Print" command from the user interface of application 42) (application 42 sends document to file manager 44 with specific destination printer and print option information) (page 2, paragraph [0025]).

27.   Claims 5-8, 13, 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Davis et al. as applied to claim 1 above, and further in view of Okigami (US

6,788,427).

28.   Regarding Claim 5, Davis et al fail to teach one or more computer readable

media, wherein the characteristics comprise at least one or more characters in a name

of the document.

Okigami teaches one or more computer readable media, wherein the

characteristics comprise at least one or more characters in a name of the document

(Fig. 5, data specifying information about the file data (i.e. the print data), such as file

name) (col. 6, lines 59-67, col. 9, lines 22-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teachings of Davis with the teaching of Okigami

to automatically chose print options based on file name.

29.   Regarding Claim 6, Davis et al fail to teach one or more computer readable

media, wherein the characteristics comprise at least a size of the document.

Okigami teaches one or more computer readable media, wherein the

characteristics comprise at least a size of the document (Fig. 5, data specifying

information about the file data (i.e. the print data), such as file size) (col. 6, lines 59-67,

col. 9, lines 22-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teachings of Davis with the teaching of Okigami

to automatically chose print options based on file size.

30.   Regarding Claim 7, Davis et al fail to teach one or more computer readable media, wherein the one or more print options are automatically identified by comparing the characteristics to a set of rules that map characteristics to print options.

Okigami teaches one or more computer readable media, wherein the one or more print options are automatically identified by comparing the characteristics to a set of rules that map characteristics to print options (changing the number of copies to be made based on data specifying information) (col. 8, lines 12-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Davis with the teaching of Okigami to use data specifying information to identify print options.

31.   Regarding Claim 8, Davis et al fail to teach one or more computer readable media, wherein the set of rules comprises at least one user-defined rule.

Okigami teaches one or more computer readable media, wherein the set of rules comprises at least one user-defined rule options (changing the number of copies to be made based on data specifying information) (col. 8, lines 12-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Davis with the teaching of Okigami to use data specifying information to identify print options.

32.   Regarding Claim 13, Davis et al teach one or more computer readable media having stored thereon a plurality of instructions that, when executed by one or more processors, causes the one or more processors to perform acts including: displaying, to a user of a client computing device including the one or more processors, a set of print

options for a remotely located printer (select "Print " command) (page 2, paragraph

[0025]), wherein a printer driver for the printer is not installed on the client computing

device (local computer can use remote printer, even if no printer driver exists for the

remote printer) (page 4, paragraph [0040]); receiving a user-selection of a sub-set of the

set of print options (application 42 sends document to file manager 44 with specific

destination printer and print option information) (page 2, paragraph [0025]).

Davis et al fail to teach one or more computer readable media storing an

indication of the print options selected in the sub-set for subsequent printing operations

for a particular user.

Okigami teaches one or more computer readable media storing an indication of

the print options selected in the sub-set for subsequent printing operations for a

particular user (storing the number of copies to be printed) (col. 6, lines 31-37, col. 8,

lines 10-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to have combined the teachings of Davis with the teaching of

Okigami to use data specifying information to identify print options.

33.   Regarding Claim 19, Davis et al fail to teach a method, wherein automatically

identifying the set of print options comprises identifying a print option configuration by

name that includes the set of print options.

Okigami teaches a method, wherein automatically identifying the set of print

options comprises identifying a print option configuration by name that includes the set

of print options (Fig. 5, data specifying information about the file data (col. 6, lines 59-

67).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to have combined the teachings of Davis with the teaching of

Okigami to use data specifying information to identify print options.

34.   Claim 20 is rejected for the same reason as claim 5.

35.   Claim 21 is rejected for the same reason as claim 6.

36.   Claim 22 is rejected for the same reason as claim 7.

37.   Claim 23 is rejected for the same reason as claim 8.

38.   Regarding Claim 24, Davis et al fail to teach a method, further comprising

analyzing previous print requests to identify patterns in characteristics of the previous

print requests and corresponding print options.

Okigami teaches a method, further comprising analyzing previous print requests

to identify patterns in characteristics of the previous print requests and corresponding

print options (Fig. 3, S23, compare print data) (co. 7, lines 1-22).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teaching of Davis with the teaching of Okigami to

allow for comparing print data to determine if same or similar print data is repeatedly

printed.

39.   Regarding Claim 25, Davis et al fail to teach a method, wherein automatically

identifying the set of print options comprises automatically identifying the set of print

options based at least in part on both the identified patterns and the one or more

characteristics of the print request.

Okigami teaches a method, wherein automatically identifying the set of print

options comprises automatically identifying the set of print options based at least in part

on both the identified patterns and the one or more characteristics of the print request

(Fig. 6, comparison result).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teaching of Davis with the teaching of Okigami to

allow for comparing print data to determine if same or similar print data is repeatedly

printed.

40.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et

al in view of Yamade (US 2002/0010806).

41.   Regarding Claim 10, Davis et al teach one or more computer readable media,

wherein the one or more print options are automatically identified by the printing device.

Davis et al fail to teach one or more computer readable media, further comprising

allowing a user of the client computing device to override the automatically identified

print options.

Yamade teaches one or more computer readable media, further comprising

allowing a user of the client computing device to override the automatically identified

print options (Fig. 8) (option display, page 4 paragraph [0068]).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to allow a user to change the print options

42.   Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Davis et al in view of Dutta (US 6,891,635).

43.   Regarding Claim 27, Davis et al teach a system comprising: an auto-select

module configured to automatically select one or more print options to be used when

printing an image identified by the print request (application 42 sends document to file

manager 44 with specific destination printer and print option information) (page 2,

paragraph [0025]).

        Davis et al fail to teach a system comprising a web server allowing an imaging

client to communicate a print request to a printer corresponding to the web server.

        Dutta teaches a system comprising a web server allowing an imaging client to

communicate a print request to a printer corresponding to the web server (user client

interacts with software located on remote printing web server to send print request

120through computer network to remote printing web server 170) (col. 3, lines 12-23).

        Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teachings of Davis with the teaching of Dutta to

use a remote printing web server for printing over the Internet.

44.   Regarding Claim 28, Davis et al fail to teach a system, wherein the auto-select

module includes a set of one or more rules that map print request characteristics to print

options, and wherein the set of one or more rules are used by the auto-select module to

automatically select the one or more print options.

        Dutta teaches a system, wherein the auto-select module includes a set of one or

more rules that map print request characteristics to print options, and wherein the set of

one or more rules are used by the auto-select module to automatically select the one or

more print options (advertising mapping table 240) (col. 3, lines 65-67, col. 4, lines 1-16,

col. 5, line 67, col. 6, lines 1-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teachings of Davis with the teaching of Dutta to

allow the internet web server to automatically choose the advertisements to be printed

based on the client's attributes.

45.   Regarding Claim 29, Davis et al fail to teach a system, wherein the auto-select

module includes a print option selector configured to analyze the print request and

identify one or more characteristics of the print request, and wherein the one or more

characteristics are used by the auto-select module to automatically select the one or

more print options.

Dutta teaches a system, wherein the auto-select module includes a print option

selector configured to analyze the print request and identify one or more characteristics

of the print request, and wherein the one or more characteristics are used by the auto-

select module to automatically select the one or more print options (advertising mapping

table 240) (col. 3, lines 65-67, col. 4, lines 1-16, col. 5, line 67, col. 6, lines 1-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teachings of Davis with the teaching of Dutta to

allow the internet web server to automatically choose the advertisements to be printed

based on the client's attributes.

46.   Regarding Claim 30, Davis et al fail to teach a system, wherein the auto-select

module includes a user print history that stores, for a plurality of previous print requests,

characteristics of each print request and print options used in printing each print

request, and wherein the user print history is used by the auto-select module to

automatically select the one or more print options.

Dutta teaches a system, wherein the auto-select module includes a user print

history that stores, for a plurality of previous print requests, characteristics of each print

request and print options used in printing each print request, and wherein the user print

history is used by the auto-select module to automatically select the one or more print

options (advertising mapping table 240) (col. 3, lines 65-67, col. 4, lines 1-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to allow the internet web server to keep track of the number of

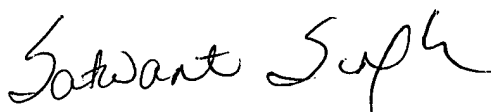times a particular advertisement has be printed out.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Satwant K. Singh whose telephone number is (571)

272-7468. The examiner can normally be reached on Monday thru Friday 8am -

4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone

number for the organization where this application or proceeding is assigned is 571-
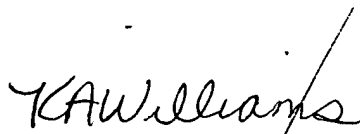
273-8300.

Information regarding the status of an application may be obtained from the
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Business Center (EBC) at 866-217-9197 (toll-free).

Satwant K. Singh
Examiner
Art Unit 2626

sks

KIMBERLY WILLIAMS
SUPERVISORY PATENT E...